



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/461,336 | 12/15/1999 | DAZHI CHEN | 23632-002 | 3675 |

29315 7590 03/15/2004

MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC
12010 SUNSET HILLS ROAD
SUITE 900
RESTON, VA 20190

EXAMINER

JAKETIC, BRYAN J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/461,336

Applicant(s)

CHEN ET AL

Examiner

Bryan Jaketic

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-153 is/are pending in the application.
4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-10, 14-16, 23-45, 49-51, 58-81, 84-98, 100, 102-112, 115-129, 131 and 133-153 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 11-13, 17-22, 46-48, 52-57, 82, 83, 99, 101, 113, 114, 130 and 132.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. Claims 1-5, 9, 10, 14, 15, 23, 29-40, 42, 44, 45, 49, 50, 58, 64-71, 73, 74, 77-81, 84, 85, 87, 88, 91-97, 100, 102, 104, 105, 108-112, 115, 116, 118, 119, 122-128, 131, and 133-148 rejected under 35 U.S.C. 103(a) as being unpatentable over Barzilai et al in view of Leonard et al. Barzilai et al disclose a method enabling businesses to post one or more items for auction, wherein the item is valid for a predetermined period of time (see col. 18, lines 7-24; theater tickets are posted, which are valid for a predetermined period of time); enabling one or more users to place a bid on the item and processing the bids to determine a winner (see Fig. 4A); and awarding the winner the item (see Fig. 4B).

Barzilai et al do not teach that the item is for a discount from a predetermined price for a period of time corresponding to a non-peak demand period. Leonard et al teach a coupon that provides a discount from a predetermined price during off-peak hours (see col. 5, lines 47-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the coupon of Leonard et al with the invention of Barzilai et al to gain customers.

Barzilai et al further disclose the step of setting a minimum bid for the item (col. 11, line 57 through col. 12, line 10).

Barzilai et al do not teach that the business is a restaurant. However, businesses have non-peak demand periods much like theaters, and restaurants have long offered "bird specials" to patrons dining at non-peak hours. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the invention of Barzilai et al to sell non-peak hour dinner certificates instead of non-peak hour theater tickets, because restaurants have the same non-peak hour needs as theaters, and selling non-peak hour certificates would help generate profit.

Barzilai et al further teach a registration process where the user provides identification, which is stored by the system (see Fig. 3).

Barzilai et al also disclose the step of displaying current auction status information comprising an auction closing time and bid information (see col. 9, lines 53 through col. 10, line 7).

Barzilai et al do not disclose an instant purchase feature. However, it is common in the art for items to be sold based on a fixed dollar amount. It would have been

obvious to one of ordinary skill in the art at the time the invention was made to employ an instant purchase feature with the invention of Barzilai et al, because many users prefer to buy items at a fixed price rather than participate in an auction.

Barzilai et al disclose a personalized auction page where the user creates an auction list comprising auctions of interest and monitors them (see Fig. 7).

Barzilai et al do not disclose the step of enabling a restaurant to display an advertisement at a premium space. However, advertising is common in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to enable a restaurant to advertise at a premium space to help promote the auction.

Barzilai et al disclose the step of displaying a list of current auctions and enabling the user to participate in a current auction (see Fig. 5 and col. 10, lines 32-57).

Barzilai et al do not disclose the step of enabling the restaurant to track and monitor bids or the number and type of items sold. However, it is common in the art for sellers to track and monitor bids and the number and type of items sold. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of enabling sellers to track and monitor bids and the number and type of items sold so they may gauge the success of the auction.

Barzilai et al do not disclose the step of providing to the restaurant a list of winning bidders. However, it is common in the art to provide the seller with the name of the bidder. It would have been obvious to one of ordinary skill in the art at the time the

Art Unit: 3627

invention was made to employ the step of providing to the restaurant a list of winning bidders so that the seller may transmit the item to the bidders.

Barzilai et al do not teach the steps of receiving an attendance report from the restaurant and collecting a fee for certificates redeemed. However, it is common in the art to charge a fee to the seller for the use of an auction web site, and it is common in the art to charge a fee only for services actually completed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the steps of receiving an attendance report from the restaurant and collecting a fee for certificates redeemed as an equitable method of generating revenue.

Barzilai et al do not disclose the use of featured auctions or the step of collecting a premium fee for featured auctions. However, featured auctions are common in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ featured auctions and charge a premium fee for them to generate additional revenue.

Barzilai et al do not teach that the winning bidder pays for the item when he is declared the winner or at the time it is used. However, it is common in the art for an auction winner to pay when he is declared the winner or at the time it is used. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of requiring payment when the winner is announced to ensure that payment is received.

4. Claims 6, 16, 41, 51, 72, 103, and 149-153 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barzilai et al and Leonard et al as applied to claims 1, 36,

71, and 102 above, and further in view of Levin et al. The combination of Barzilai et al and Leonard et al teach the limitations of the claims as described in paragraph 3 of this Office Action. Barzilai et al and Leonard et al fail to disclose a search engine for searching for auctions by restaurant name or cuisine type. Levin discloses a search engine that allows users to search for restaurants by cuisine type (col. 3, lines 25-43 and col. 12, line 51 through col. 13, line 15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the search engine of Levin et al with the combination of Barzilai et al and Leonard et al to help users find restaurants of interest.

5. Claims 7, 8, 24, 43, 59, 86, 106, 107, and 117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barzilai et al and Leonard et al as applied to claims 1, 36, 71, 102, and 105 above, and further in view of Fisher et al. Barzilai et al and Leonard et al teach the limitations of the claims as detailed in paragraph 3 of this Office Action. Barzilai et al and Leonard et al fail to disclose the steps of enabling bidders to place a quantity of item amount and a bid amount nor do they disclose an auto-bid feature. Fisher et al disclose the steps of enabling bidders to place a quantity of item amount and a bid amount (col. 8, lines 39-55). Fisher et al also disclose an auto-bid feature that allows the user to submit a maximum bid amount and a bid increment amount where the bids are automatically incremented to the maximum amount (col. 8, line 56 through col. 9, line 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Fisher et al with the combination of Barzilai et al and Leonard et al to allow bidders to

place a quantity of item amount and a maximum bid amount for the bidders convenience.

Barzilai et al and Leonard et al fail to disclose the steps of enabling the restaurant to set an auction schedule. Fisher et al disclose the step of enabling a seller to set an auction schedule (col. 8, lines 13-38). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Fisher et al with the combination of Barzilai et al and Leonard et al to allow a seller to set a schedule to allow him to sell items at a time he prefers.

6. Claims 75 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barzilai et al, Leonard et al, and Levin et al as applied to claim 72 above, and further in view of Fisher et al. Barzilai et al, Leonard et al, and Levin et al disclose the limitations of the claims as detailed in paragraph 4 of this Office Action. Barzilai et al, Leonard et al, and Levin et al do not disclose the steps of enabling bidders to place a quantity of item amount and a bid amount nor do they disclose an auto-bid feature. Fisher et al disclose the steps of enabling bidders to place a quantity of item amount and a bid amount (col. 8, lines 39-55). Fisher et al also disclose an auto-bid feature that allows the user to submit a maximum bid amount and a bid increment amount where the bids are automatically incremented to the maximum amount (col. 8, line 56 through col. 9, line 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Fisher et al with the combination of Barzilai et al, Leonard et al, and Levin et al to allow bidders to place a quantity of item amount and a maximum bid amount for the bidders convenience.

Barzilai et al, Leonard et al, and Levin et al do not disclose the steps of enabling the restaurant to set an auction schedule. Fisher et al disclose the step of enabling a seller to set an auction schedule (col. 8, lines 13-38). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Fisher et al with the combination of Barzilai et al, Leonard et al, and Levin et al to allow a seller to set a schedule to allow him to sell items at a time he prefers.

7. Claims 25-28, 60-63, 89, 90, 98, 120, 121, and 129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barzilai et al and Leonard et al as applied to claims 1, 36, 71, and 102 above, and further in view of Boe et al. Barzilai et al and Leonard et al teach the limitations of the claims as described in paragraph 3 of this Office Action. Barzilai et al and Leonard et al fail to disclose the step of creating a survey for users to complete to receive targeted marketing and promotions. Boe et al disclose a system for profiling customers for targeted marketing comprising the steps of providing surveys for users to provide demographic information (col. 2, line 60 through col. 3, line 55) or purchase history data (504). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Boe et al with the combination of Barzilai et al and Leonard et al to provide sellers with information that would aid both present and future sales.

Response to Arguments

8. Applicant's arguments with respect to claims 1-153 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

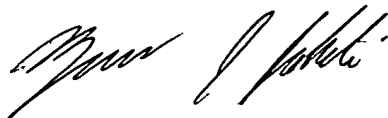
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Walker et al disclose an "early bird" promotion. Lowell discloses incentives for off-peak activities. Broker et al teach the use of special prices for off-peak hours. Daitokyo discloses gift certificates that are only valid for specified times.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Jaketic whose telephone number is (703) 308-0134. The examiner can normally be reached on Monday through Friday (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703)308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bj



3/9/04